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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/928,942      | 08/13/2001  | Margaret Jane Burton | 10006708-1          | 8090             |

7590 04/06/2005

HEWLETT-PACKARD COMPANY  
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| EXAMINER |
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GREENE, DANIEL L

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| ART UNIT | PAPER NUMBER |
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3621

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/928,942

**Applicant(s)**

BURTON ET AL.

**Examiner**

Daniel L. Greene

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-5, 7, 8, 11-13, 15, 16, 19-22 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-5, 7, 8, 11-13, 15, 16, 19-22, 24-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 1/4/2005 have been fully considered but they are not persuasive. The Applicant argues that Wyman (primary prior art) generates licenses as the result of oral negotiations between the user of a program 26 and the user of the server 10. Also, " **Such negotiations are not facilitated by the system described by Wyman**" (bold letters by Applicant to tie back to bold letters in the reproduction of Wyman passage). The Examiner upon further review of Wyman has determined that the use of the terms communication between delegates and entities in Wyman may give the impression that Wyman is teaching about oral communications when in fact he is not. The section that the Applicant refers to is part of the description of Figure 1 originating at column 9, line 25. Wyman establishes the mode of communications in the first section of his reference to Figure 1 by disclosing, " The license server **10** communicates with a number of delegates **13** which likewise includes CPUs in departments..." Col. 9, lines 30-32. Proceeding upstream to the License Issuer **25** and Producer **28**, use of CPUs/servers is taught and maintained via the operating system **27**. Wyman further discloses the use of communications link via the form of a network, or may be a phone line using a modem. Col. 10, lines 45-55. This section teaches away from the use of oral communications.
2. The Applicant expands upon his "oral" premise by stating " Wyman describes a system that is labor intensive in that it requires licenses to be individually negotiated and then the system is executed to insure compliance with the license." Page 9, Last

Art Unit: 3621

paragraph. The Examiner submits that, as per the previous paragraph that Wyman teaches away from and is not a oral orientated system, which renders the Applicant's "oral" premise null and void.

3. Claims 3-5, 7, 8, 11-13, 15, 16, 19-22, and 24-26 are pending.

### **DETAILED ACTION**

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 3-5, 7, 8, 11-13, 15, 16, 19-22, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyman U.S. Patent 5,260,999 [Wyman] , and further in view of Stefik et al..U.S. Patent 6,714,921 [Stefik].**

- 3.

The recitation that , a method, a program, and a system has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a method, a system, an apparatus, etc. and the portion of the claim following the preamble is a self-contained description of the method or the system, etc., not depending for completeness upon the introductory clause.

*Kropa v. Robie, 88 USPQ 478 (CCPA 1951)*

As per claims 3, 11 and 19:

Wyman discloses:

maintaining a number of entities in the license repository in a server, Col. 6, lines 43-67, by maintaining a profile for each of the entities, Col. 20, lines 28-35, the number entities including a number of licensors and a number of licensees; Col. 6, lines 43-67, each of the profiles including point of contact for at least one of the entities in the license repository. Col. 20, lines 28-35.

generating a number of licenses between respective pairs of the licensees and the licensors based upon an input from at least one of the licensees and the licensors, respectively; Col. 7, lines 49-67

maintaining the licenses in the license repository. Col. 10, lines 30-55.

wherein the step of generating the number of licenses between respective pairs of the licensees and the licensors based upon the input from the at least one of the licensees and the licensors, further comprises: Col. 11-12, lines 1-67.

generating a first one of the licenses based upon a unilateral input by a first one of the entities; Col. 11-12, lines 1-67.

notifying a second one of the entities that is party to the first one of the licenses of the creation of the first one of the licenses. Col. 11-12, lines 1-67.

wherein the first one of the licenses is unconfirmed; Col. 8, lines 5-20: and

receiving a confirmation status input from the second one of the entities indicating whether the first one of the licenses is confirmed. Col. 8, lines 5-20.

Wyman discloses the claimed invention except for the use of the term Repository. Stefik teaches that it is known in the art to provide a repository for maintaining the licenses. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the storage of the licenses of Wyman with the storage of the licenses in a repository of Stefik, in order to further clarify the storage function.

As per claims 4, 12, and 20:

Wyman further discloses:

further comprising maintaining a confirmation status of at least one of the licenses in the license repository. Fig. 27.

As per claims 5, 13, and 22:

Wyman discloses the claimed invention except for the modifying a first one of the profiles in the license repository based upon a modification input received from a first one of the entities; and notifying a second one of the entities that is party to one of the licenses with the first one of the entities of the modifying of the first one of the profiles.

Stefik teaches that it is known in the art to provide modifying a first one of the profiles in the license repository based upon a modification input received from a first one of the entities; and notifying a second one of the entities that is party to one of the licenses with the first one of the entities of the modifying of the first one of the profiles. Col. 41-42, lines 1-67.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the registration function of Wyman with the modifying a first one of the profiles in the license repository based upon a modification input received from a first one of the entities; and notifying a second one of the entities that is party to one of the licenses with the first one of the entities of the modifying of the first one of the profiles of Stefik, in order to facilitate the tracking of the use of the selected program..

As per claims 7, 15, and 21:

Wyman further discloses:

maintaining a number of license products associated with at least one of the licensors in the license repository. Col. 24-25, lines 1-67.

As per claims 8, 16, and 24:

Wyman further discloses:

an additional one of the number of license products in the license repository based upon a license product input from the at least one of the licensors. Col. 28, lines 35-67.

As per claim 25:

Wyman further discloses:

wherein the step of maintaining the confirmation status of the at least one of the licenses in the license repository further comprises indicating whether the at least one of the licenses is denied. Col. 38, lines 35-40.

As per claim 26:

Wyman further discloses:

wherein the step of maintaining the confirmation status of the at least one of the licenses in the license repository further comprises indicating whether the at least one of the licenses is confirmed. Col. 38, lines 20-25.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.



Art Unit: 3621

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703-306-5539. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
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Daniel L. Greene  
Examiner  
Art Unit 3621

3/28/2005